

REMARKS

Applicants have carefully reviewed the Office Action mailed July 7, 2010 (hereinafter "Office Action"), and respectfully request reconsideration of the subject application, particularly in view of the above amendments and the following remarks.

Status of the Claims

Claims 26-45 were previously pending. Claims 1-25 were previously cancelled. Claims 26, 33, and 40 have been amended to clarify aspects of Applicants' invention as discussed in greater detail herein. Such amendments are supported by at least paragraphs 0019-0022 of the subject application. Claims 27, 28, 34, 35, and 41 have been amended in view of the amendments to claims 26, 33, and 40. Claims 29, 36, and 42 have been cancelled because of the incorporation of the subject matter of such claims into the independent claims from which such claims previously depended. Accordingly, claims 26-28, 30-35, 37-41, and 43-45 are pending.

Interview Summary

Applicants thank Examiner Vig for the courtesies extended during the telephonic interview conducted on October 4, 2010. During the Interview, the undersigned pointed out distinctions between claim 26 and U.S. Patent No. 5,704,029 to Wright, Jr. (hereinafter "Wright") and U.S. Patent No. 7,466,347 B2 to Tsunoda (hereinafter "Tsunoda"). The Examiner made some suggestions for amendments which may further clarify such features, several of which are now reflected in claims 26, 33, and 40. No agreement regarding allowability of the claims was reached.

Rejection Under 35 U.S.C. § 103(a) – Wright and Tsunoda

Claims 26-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright in view of Tsunoda. Applicants respectfully traverse. When determining whether a claim is obvious, an Examiner must make "a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR Int’l Co. v. Teleflex, Inc., 550 U.S. 398, 418, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Applicants’ invention relates to a portable image capture device, such as a camera. Templates are stored on another device, such as a computer. Template identifiers and input identifiers are stored in a memory of the capture device, but the templates are not. A user may select a template identifier; in response, the portable image capture device obtains the input identifiers that are associated with the template identifier from a memory of the capture device and, based on the input identifiers, prompts the user to capture data. The capture device stores the data in association with the respective input identifiers. The template identifier, input identifiers, and captured data may then be communicated to the computer on which the template is stored, and the captured data may be integrated with the template to generate a document.

Wright discloses a personal digital assistant (PDA) that may execute a form via a forms engine that runs on the PDA to prompt a user to collect data (Wright, Abstract). Wright fails to disclose template identifiers because Wright discloses to load forms onto the PDA (see, e.g., elements 120-122 of Fig. 1 of Wright). In contrast, Applicants’ claim 26 recites *“selecting, via a portable image capture device, a first template identifier stored in the portable image capture device, wherein the first template identifier identifies a first template that is not stored in the portable image capture device.”* Thus, among other advantages, Applicants’ invention reduces memory requirements associated with the storage of templates. Applicants’ claim 26, as amended, also recites *“communicating the first template identifier and the first data to a computer on which the first template is stored for integration of the first data into the first template.”* Wright fails to teach or suggest this feature, because the data collected in Wright is integrated into the form on the PDA, not on another device. The Patent Office refers to column 28, lines 28-50, of Wright as allegedly disclosing various features of Applicants’ claim 26, and in particular notes that Wright discloses that “[t]he system finds use in any application in which data is collected procedurally or algorithmically” (Office Action, page 4). (Applicants note that during the Interview, the Examiner indicated that the reference to Tsunoda, column 28 at the top of page 4 of the Office Action was inadvertent and was intended to be a reference to Wright, column 28.) Applicants submit that a broad statement that the invention disclosed in Wright may

be used in many different applications does not constitute a disclosure of specific features that are recited in Applicants' claims. For example, the fact that the invention disclosed in Wright may have applicability in many different applications does not disclose the use of template identifiers and input identifiers that are stored in a capture device and are associated with a template that is not stored in the capture device, as recited in Applicants' claims.

Tsunoda fails to remedy Wright's deficiencies. Tsunoda discloses a document drafting system wherein a camera contains a template (Tsunoda, Abstract). After taking a photograph, a user of the camera may select the template (Tsunoda, column 6, lines 52-61). The photograph is then posted into the template (*Id.*).

In contrast, Applicants' invention does not store a template in the portable image capture device. Rather, Applicants' invention stores template identifiers and input identifiers associated with corresponding template identifiers. Nowhere does Tsunoda teach or suggest storing template identifiers and input identifiers for a template that is not stored in the camera. Rather, Tsunoda teaches to store entire templates in the camera.

For at least the foregoing reasons, Applicants submit that claim 26 is allowable over the cited references. Claims 33 and 40 contain limitations substantially similar to those discussed herein with regard to claim 26, and should therefore be allowable for at least the same reasons.

Applicants' claim 28 depends from claim 27, and in conjunction with claim 27 requires the capture of second data based on a second prompt, and further requires that the template identifier, first data, and second data be communicated to a computer, where the data is integrated by the computer into the first template to generate a document. Nowhere does either Wright or Tsunoda teach or suggest the communication of a template identifier, first data, and second data to a computer, wherein the data is integrated into a template to generate a document. Thus, Applicants believe claim 28 is allowable over the cited references. Claim 35, which depends from claim 34, in conjunction with claim 34 contains limitations substantially similar to those discussed herein with regard to claim 28, and should therefore be allowable for at least the same reasons.

Claims 30-32 depend directly or indirectly from claim 26, and should therefore be allowable as depending from an allowable independent claim. Claims 37-39 depend directly or indirectly from claim 33, and should therefore be allowable as depending from an allowable

independent claim. Claims 41 and 43-45 depend directly or indirectly from claim 40, and should therefore be allowable as depending from an allowable independent claim.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



Eric P. Jensen
Registration No. 37,647
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: October 7, 2010
Attorney Docket: 1104-063